

### **Remarks/Arguments**

Reconsideration of the above-captioned application in light of the forgoing amendments and the following remarks is respectfully requested.

Slight changes have been made to the specification and drawings and the original claims have been cancelled in favor of new claims 37-56.

Although some of the previous claims were rejected under 35 U.S.C. §102(b) as being anticipated by Wilson, it is submitted that the Wilson patent is not applicable to new independent claim 37 for the following reasons.

New claim 37 recites at least one weir extending from one of a set of walls forming a chamber and partially across the chamber towards an opposite wall. A surface of the weir is spaced from the opposite wall and defines, with the opposite wall, a first space for fluid flow between the weir and the opposite wall that varies along a dimension of the chamber. A least one additional weir is provided that extends from the opposite wall and partially across the chamber towards the one wall. A surface of the additional weir is spaced from the one wall and defines, with the one wall, a second space for fluid flow between the additional weir and the one wall that varies along another dimension of the chamber.

The PTO provides in MPEP §2131 that

*"[t]o anticipate a claim, the reference must teach every element of the claim...."*

Therefore, with respect to claim 37, to sustain this rejection the Wilson patent must contain all of the above claimed elements of the claim. However, this patent does not disclose at least one weir extending from one of a set of walls defining a chamber, and partially across the chamber towards an opposite wall; a surface of the weir spaced from the opposite wall and defining, with the opposite wall, a first space for fluid flow between the weir and the opposite wall that varies along a dimension of the chamber; at least one additional weir that extends from the opposite wall and partially across the chamber towards the one wall, with a surface of the additional weir being spaced from the one wall and defining, with the one wall, a second space for fluid flow between the additional weir and the one wall that varies along another dimension of the chamber.

It thus follows that the previous rejection based on 35 U.S.C. §102(b) cannot be supported by the Wilson reference as applied to new claim 37.

Although several original claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Wilson and over Wilson in view of Touzalin, et al, it is submitted that these patents are not applicable to new independent claim 37 since they are defective in establishing a prima facie case of obviousness in accordance with the following from §2142 of the MPEP:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

**1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The Wilson and Touzalin, et al, patents cannot be applied to reject claim 37 under 35 U.S.C. §103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither Wilson nor Touzalin, et al, teaches at least one weir extending from one of a set of walls and partially across the chamber towards an opposite wall; a surface of the weir spaced from the opposite wall and defining, with the opposite wall, a first space for fluid flow between the weir and the opposite wall that varies along a dimension of the chamber; at least one additional weir that extends from the opposite wall and partially across the chamber towards the one wall, with a surface of the additional weir being spaced from the one wall and defining, with the one wall, a second space for fluid flow between the additional weir and the one wall that varies along another dimension of the chamber. Therefore, it is impossible to render the

subject matter of claim 37 as a whole obvious, and the above explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

## **2. The Combination of References is Improper**

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the Wilson and Touzalin, et al, patents cannot be combined and applied to reject claim 37 under 35 U.S.C. §103.

§2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed "as a whole".*

Here, neither Wilson nor Touzalin, et al, teaches, or even suggests, the desirability of the combination since neither teaches or suggests providing at least one weir extending from one of a set of walls defining a chamber, and partially across the chamber towards an opposite wall; a surface of the weir spaced from the opposite wall and defining, with the opposite wall, a first space for fluid flow between the weir and the opposite wall that varies along a dimension of the chamber; at least one additional weir that extends from the opposite wall and partially across the chamber towards the one wall, with a surface of the additional weir being spaced from the one wall and defining, with the one wall, a second space for fluid flow between the additional weir and the one wall that varies along another dimension of the chamber, as claimed in claim 37.

Thus, it is clear that neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection of claim 37.

In this context, the MPEP further provides at §2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 37. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and any rejection under 35 U.S.C. §103 is not applicable to claim 37.

New independent claim 47 is a method version of claim 37 and therefore is allowable for the above reasons.

Dependent claims 38-46 and 46-56 further limit claims 37 and 47, respectively, in a patentable sense and, for the reasons indicated above, are also deemed to be in condition for allowance.

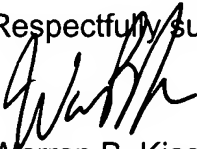
Should the Examiner have any questions or comments regarding this amendment, he is invited to telephone the undersigned at the number listed below.

In view of the forgoing, and early formal notice of allowance is respectfully requested.

Attorney Docket No. HES 2000-IP-001843U1  
Haynes and Boone's Ref.: 30545.13  
Customer No. 000028857

The Commissioner is hereby authorized to charge payment of any further fees associated with any of the papers submitted herewith or to credit any overpayment to Deposit Account No. 08-1394.

Respectfully submitted,

  
Warren B. Kice  
Registration No. 22,732

Date: 1/29/04

HAYNES AND BOONE, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 214-651-5634  
Facsimile: 214 200-0853  
File: 30545.13

D-1208310.1


EXPRESS MAIL NO.: EV 333 440003 US

DATE OF DEPOSIT: January 29, 2004

This paper and fee are being deposited with the U.S. Postal Service Express Mail Post Office to Addressee service under 37 CFR §1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

**SANDRA KUBIN**

Name of person mailing paper and fee



Signature of person mailing paper and fee